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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/677,701	09/28/2000	Terrance Dishongh	042390.P9481	3388

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EXAMINER

IP, SIKYIN

ART UNIT	PAPER NUMBER
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1742

DATE MAILED: 01/03/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

Applicant(s)

Examiner

Group Art Unit

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

- ☒ Responsive to communication(s) filed on 6/28/02 ; 10/11/02
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 1 1; 453 O.G. 213.

Disposition of Claims

- ☒ Claim(s) 2-3, 5-6, 9-11, 13, 16-17, 19-20, 22, 24-28 is/are pending in the application.
- Of the above claim(s) 9-11, 13, 28 is/are withdrawn from consideration.
- ☐ Claim(s) _____ is/are allowed.
- ☒ Claim(s) 2, 3, 5, 6, 16-20, 22, and 24-27 is/are rejected.
- ☐ Claim(s) _____ is/are objected to.
- ☐ Claim(s) _____ are subject to restriction or election requirement.

Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
 - ☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been received.
 - ☐ received in Application No. (Series Code/Serial Number) _____.
 - ☐ received in this national stage application from the International Bureau (PCT Rule 1 7.2(a)).

*Certified copies not received: _____

Attachment(s)

- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____
- ☒ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Interview Summary, PTO-413
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Other _____

Office Action Summary

Serial No: 09/677,701

Art Unit: 1742

-2-

DETAILED ACTION

Election/Restriction

1. Applicant's election without traverse of Group I, claims 2, 3, 5, 6, 16-20, 22, and 24-27, in Paper No. 10, filed October 11, 2002 is acknowledged.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:
The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
3. Claims 16, 17, and 27 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
4. Claim 16 is indefinite because the expression "said subjecting" has no antecedent basis.
5. Claim 27 is indefinite because the expression "the thermal conductivity" has no antecedent basis.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claim 27 is rejected under 35 U.S.C. 102(b) as being clearly anticipated by USP 4961987 to Okuno et al (col. 4, lines 61-68 and col. 5, lines 42-55) or USP 5465184 to Pickering et al (col. 4, lines 51-66). Both cited references teach to increase grain size of a material in order to increase thermal conductivity for dissipating heat.

Claim Rejections - 35 USC § 103

8. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

9. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

10. Claims 2, 3, 5, 6, 16-20, 22, and 24-26 are rejected under 35 U.S.C. § 103 as

being unpatentable over USP 3184349 to Burwen in view of USP 3185600 to Dullberg and further teaching of USP 20010035557 to Akram and USP 4961987 to Okuno et al.

11. The Burwen reference(s) disclose(s) the features including the claimed method steps of heating and cryogenic cooling an electronic equipment material (aluminum alloy). The features relied upon described above can be found in the reference(s) at: col. 2, line 58 to col. 3, line 30. The difference between the reference(s) and the claims are as follows: Burwen does not explicitly disclose said material is a heat sink and larger grain size of the heat sink material would enhance heat dissipation.

However, Akram in Figures 1, 3, and 5 and claim 34 disclose(s) heat sink structures and materials include aluminum, copper, etc and their alloys. Dullberg in col. 2, lines 55-70 discloses materials that could be treated by cryogenic cooling. Therefore, it would have been obvious to one having ordinary skill in the art of the cited references at the time the invention was made to recognize the teaching of Burwen could be used for heat treating a heat sink and/or mounting a heat sink in view of the teaching of Akram (Figures 1, 3, and 5). Moreover, since the claimed heat sink has no structure being defined, it reads on the material and structure as disclosed by Burwen. In re Venner, 120 USPQ 193 (CCPA 1958), In re LaVerne, et al., 108 USPQ 335, and In re Aller, et al., 105 USPQ 233.

12. Okuno et al in col. 2, lines 27-32 teach heat sink material, in col. 4, lines 61-69 disclose larger grain would have better thermal conductivity, and in col. 5, lines 42-55 disclose larger grain could be obtained by higher heating temperature.

Therefore, ordinary skill artisan would recognize the heated material of Burwen would have grain size changed from small to larger size.

Response to Arguments

13. Applicant's arguments with respect to elected claims have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

14. The above rejection relies on the reference(s) for all the teachings expressed in the text(s) of the references and/or one of ordinary skill in the metallurgical art would have reasonably understood or implied from the text(s) of the reference(s). To emphasize certain aspect(s) of the prior art, only specific portion(s) of the text(s) have been pointed out. Each reference as a whole should be reviewed in responding to the rejection, since other sections of the same reference and/or various combination of the cited references may be relied on in future rejection(s) in view of amendment(s).

All recited limitations in the instant claims have been met by the rejections as set forth above.

Applicant is reminded that when amendment and/or revision is required, applicant should therefore specifically point out the support for any amendments made to the disclosure. See MPEP § 2163.06 (a) and 37 C.F.R. § 1.119.

Serial No: 09/677,701

-6-


Art Unit: 1742

Examiner Correspondence

Any inquiry concerning this communication or earlier communications from the examiner should be directed to S. Ip whose telephone number is (703) 308-2542. The examiner can normally be reached on Monday to Friday from 5:30 A.M. to 2:00 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dr. Roy V. King, can be reached on (703)-308-1146.

The facsimile phone number for this Art Unit 1742 are (703) 305-3601 (Official Paper only) and (703) 305-7719 (Unofficial Paper only). When filing a FAX in Technology Center 1700, please indicate in the Header (upper right) "Official" for papers that are to be entered into the file, and "Unofficial" for draft documents and other communication with the PTO that are not for entry into the file of the application. This will expedite processing of your papers.



SIKYIN IP
PRIMARY EXAMINER
ART UNIT 1742

S. Ip
December 30, 2002